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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LIVERSEDGE, JENNIFER L	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/917,258	MAKINO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer Liversedge	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/917,258.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities:

Page 18, line 9: ATM monitoring apparatus 2 should be 4.

Applicant should review specification for similar corrections.

Appropriate correction is required.

### ***Drawings***

The drawings are objected to because:

Figure 1 should contain labels for Items 4a and 4b.

Figure 1 should include reference numbers for TCP/IP link and Dnet.

Figure 2 should include labels for Items 16, 17, 18 and 19.

Applicant should review other drawings for similar corrections.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim includes that a game display information is "to be printed on a game card dispensed at the terminal" and further claims "the game card having portions to be rubbed away...". The Examiner is uncertain how the card would be printed at the terminal and contain portions to be rubbed away. This would involve multiple processes not contained within the claims, and renders claim 18 as failing to comply with the enablement requirement. For purposes of examination, the interpretation was made for a game card containing portions to be scratched away but not requiring printing. The examiner also notes that electronic versions of scratch-and-win games are known in the

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art but were not cited as the interpretation made was that Applicant is claiming an actual game card.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 14-17, 22-26 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,973,442 B1 to Drummond et al (further referred to as Drummond).

Regarding claim 1, Drummond discloses in a data processing network (column 6, lines 25-41) having a self-service terminal (column 6, lines 29-33) and an information processing system (column 6, lines 25-67), the information processing system in two-way communication with the terminal (column 6, lines 32-41), a method for providing customer-specific service that is adapted to a customer conducting a transaction at the terminal (column 16, lines 4-67), said method comprising:

Storing, in advance of the transaction, customer service information in the information processing system (column 16, lines 4-15), the customer service information comprising

Customer attribute information associated with that customer (column 16, lines 22-32), and

Customer offer information used for implementing a customer-specific service for that customer (column 16, lines 22-32);

Retrieving customer offer information at the information processing system and transmitting the customer offer information to the terminal (column 11, lines 16-38);

Transmitting transaction-specific customer information from the terminal to the information processing system in response to the customer conducting a transaction at the terminal (column 7, lines 25-48; column 11, lines 16-38); and

Providing the customer offer information to the customer at the self-service terminal in response to the transaction-specific customer information (column 16, lines 4-67).

Regarding claim 2, Drummond discloses the method wherein the self-service terminal is an automated teller machine (ATM) (column 6, lines 25-41).

Regarding claim 3, Drummond discloses the method wherein the customer attribute information comprises information identifying either one or both of (a) particular

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personal attributes of the customer and (b) attributes of an account maintained for the customer (column 13, lines 13-34; column 16, lines 1-3 and 22-28).

Regarding claim 4, Drummond discloses wherein the customer attribute information further comprises data identifying the bank account of the customer (column 5, lines 5-19).

Regarding claim 5, Drummond discloses the method wherein the customer attribute information further comprises the address of the customer (column 12, lines 53-56; column 13, lines 24-30).

Regarding claim 6, Drummond discloses the method wherein the customer attribute information further comprises data relating prior transactions conducted by the customer (column 16, lines 25-29; column 23, lines 13-18).

Regarding claim 14, Drummond discloses the method wherein the customer offer information comprises information for implementing a customer-specific service a plurality of customers having related customer attribute information (column 17, line 65-column 18, line 1).

Regarding claim 15, Drummond discloses the method wherein the terminal dispenses a card to the customer and wherein the customer offer information comprises

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display information to be printed on the card by the terminal (column 1, lines 39-42).

Drummond discloses coupons, tickets, etc. all of which could be “cards” which is a relative term and will be interpreted to include items as disclosed by Drummond.

Regarding claim 16, Drummond discloses the method wherein the customer offer information further comprises display information of potential interest to a plurality of customers having related customer attribute information, said display information comprising promotion display information relating to a promotional event of potential interest to the customers (column 17, line 65-column 18, line 1).

Regarding claim 17, Drummond discloses the method wherein the customer offer information further comprises administrator display information having instructions for directing the customers to a human administrator for further action in connection with the promotional event (column 16, lines 15-67).

Regarding claim 22, Drummond discloses the method wherein the transaction-specific customer information transmitted from the terminal comprises data identifying the customer (column 12, line 37 – column 13, line 30; column 14, lines 20-27).

Regarding claim 23, Drummond discloses the method wherein the transaction-specific customer information transmitted from the terminal further comprises data



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identifying the type of transaction being conducted by the customer (column 9, lines 47-52; column 13, line 60 – column 14, line 5; column 17, lines 12-25).

Regarding claim 24, Drummond discloses the method wherein the transaction-specific customer information transmitted from the terminal further comprises data identifying an account of the customer (column 12, line 37 – column 13; column 16, lines 22-33; column 17, lines 6-40).

Regarding claim 25, Drummond discloses the method wherein the data processing network is a bank automated teller machine (ATM) network, wherein the terminal is an ATM (column 6, lines 25-41), wherein the data processing network further comprises a central accounting system for controlling financial transactions in the network and a separate central business system for storing customer service information (column 10, lines 34-57; column 16, lines 4-15; column 17, lines 33-40), wherein the central accounting system and the central business system are each located remotely from the terminal and the information processing system (column 7, lines 1-13; column 17, lines 33-36), and wherein the step of storing customer service information in the information processing system includes the step of downloading customer service information from the central business system to the information processing system (column 11, lines 26-30; column 18, lines 62-65; column 19, lines 4-63).

Regarding claim 26, Drummond discloses the method wherein the central accounting system is connected to the terminal and wherein the central business system is separately connected to the information processing system (column 19, lines 4-63).

Regarding claim 28, Drummond discloses a data processing network (column 6, lines 25-41), comprising:

A plurality of self-service terminals (column 6, lines 29-33), providing customer-specific service to a customer conducting transactions at the terminals (column 16, lines 4-67; and

An information processing system (column 6, lines 25-67 connected in two-way communication with the terminals (column 6, lines 32-41);

Wherein the self-service terminals transmit transaction-specific customer information from the terminals to the information processing system in response to a customer initiating a transaction at the terminals (column 16, lines 4-67);

Wherein the information processing system stores customer service information in advance of transactions (column 16, lines 4-15), the customer service information comprising

Customer attribute information related to attributes of the customer (column 16, lines 22-32), and

Customer offer information that implements a customer-specific service for the customer and that is associated with the customer attribute information (column 16, lines 22-32); and

Wherein the information processing system retrieves and transmits the customer offer information to the terminals (column 7, lines 25-48; column 11, lines 16-38), and

Wherein the terminal provides the customer offer information that terminal to a customer having associated attributes, in response to the transaction-specific customer information (column 16, lines 4-67).

Regarding claim 29, Drummond discloses the network wherein the data processing network is a bank automated teller machine (ATM) network, wherein the terminals are ATMs (column 6, lines 25-41), wherein the data processing network further comprises a central accounting system for storing transactional data and a separate central business system for storing customer service information (column 10, lines 34-57; column 16, lines 4-15; column 17, lines 33-40), wherein the central accounting system and the central business system are each located remotely from the terminal and the information processing system (column 7, lines 1-13; column 17, lines 33-36), and wherein customer service information is stored in advance in the information processing system by downloading the customer service information from the central business system to the information processing system (column 11, lines 26-30; column 18, lines 62-65; column 19, lines 4-63).

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Regarding claim 30, Drummond discloses the network wherein the central accounting system is connected to the terminals and wherein the central business system is separately connected to the information processing system for downloading the customer's service information (column 19, lines 4-63).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond.

Regarding claims 27 and 31, Drummond does not disclose the method wherein the step of downloading customer service information from the central business system

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comprises the steps of storing the customer service information on information-recording medium, and then installing the information-recording medium at the information processing system. However, Drummond does disclose where records are downloaded via servers and the Internet. As these mechanisms of data file transfer are more current than the practice of downloading via a recordable medium, it would be obvious to one of ordinary skill in the art that the process of downloading could be achieved using this more dated form of data downloading.

Claims 7 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond as applied to claim 3 above, and further in view of "Citibank Unveils New Automatic Teller Machine Technology to Aid Individuals with Disabilities" by S. Weeks, Sept. 30, 1992 (further referred to as Weeks).

Regarding claim 7, Drummond does not disclose wherein the customer attribute information further comprises data identifying whether the customer is sight-impaired and wherein the customer offer information operates the terminal so as to increase the size of the transaction information displayed on the terminal.

Drummond does disclose storing customer attribute information wherein examples of information stored include gender and customer preferences (column 16, lines 22-32). It would be obvious to one of ordinary skill in the art that if information such as customer gender is stored, that customer disability data could also be stored as part of the customer profile information.

Further, Drummond discloses the use of HTML documents with tags assigned to control such features as fonts and layouts, such that the tags tell the browser how to display the information (page 2, lines 50-63). It would be obvious to one of ordinary skill in the art that the well known use of tags to control font size could be used to both increase and decrease font size as required or desired. Drummond discloses wherein user information is stored and wherein users can establish preferences based on their stored information and wherein tags are used to display items on the screen according to those tags. Therefore, it would be obvious to one of ordinary skill in the art that tags could be used to indicate printing larger font for those customers who are visually impaired.

Further, Weeks discloses ATM technology to facilitate the accessibility of such individuals as visually impaired through the use of a large font size (page 2, lines 5-7 and lines 19-21).

It would be obvious to one of ordinary skill in the art to combine the use of large font size for conducting ATM transactions by the visually impaired as disclosed by Weeks with the ATM system as disclosed by Drummond. The motivation would be to provide ATM services for all individuals using existing technology to do so.

Regarding claim 8, Drummond does not disclose wherein the customer attribute information stored in the information processing system further comprises data identifying the age of the customer and wherein the customer offer information operates

the terminal so as to increase the size of the transaction information displayed on the terminal.

Drummond does disclose storing customer attribute information wherein examples of information stored include gender and customer preferences (column 16, lines 22-32). It would be obvious to one of ordinary skill in the art that if information such as customer gender is stored, that customer age data would also be stored as providing one's birth date is commonplace in establishing accounts of various natures.

Further, Drummond discloses the use of HTML documents with tags assigned to control such features as fonts and layouts, such that the tags tell the browser how to display the information (page 2, lines 50-63). It would be obvious to one of ordinary skill in the art that the well known use of tags to control font size could be used to both increase and decrease font size as required or desired. Drummond discloses wherein user information is stored and wherein users can establish preferences based on their stored information and wherein tags are used to display items on the screen according to those tags. Therefore, it would be obvious to one of ordinary skill in the art that tags could be used to indicate printing larger font for those customers who are elderly.

In the same way as the font modification can be made for those who are visually impaired, font modifications can be made for any personal preference or requirement. Weeks refers to people with physical disabilities as discussed in the claim 7 rejection and the same combination and motivation apply to claim 8.

Claim 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond as applied to claim 3 above, and further in view of "Neglected Shoppers Rejoice: Customer Service is Returning" by B. Aarsteinsen, Nov. 9, 1990 (further referred to as Aarsteinsen).

Regarding claim 9, Drummond does not disclose the method wherein the customer attribute information comprises data identifying the customer as having special customer status. However, Aarsteinsen discloses the method wherein the customer attribute information comprises data identifying the customer as having special customer status (page 2, lines 49-52). It would be obvious to one of ordinary skill in the art to combine using the label of special customer as disclosed by Aarsteinsen with the ATM promotional and communication services as disclosed by Drummond. The motivation would be to create a label for the customers which Drummond segments/individualizes when their profile indicates they are a special customer and deserving of attention and focus.

Regarding claim 10, Drummond does not disclose the method wherein the customer offer information comprises data causing the information processing system to notify a human administrator of the special customer status. However, Aarsteinsen discloses the method wherein the customer offer information comprises data causing the information processing system to notify a human administrator of the special customer status (page 2, lines 14-19). It would be obvious to one of ordinary skill in the



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art to combine notifying a human administrator regarding a special customer as disclosed by Aarsteinsen with the ATM promotional and communication services as disclosed by Drummond. The motivation would be to be sure that special customers were given the highest level of service available and to have a positive experience during their transaction.

Regarding claim 11, Drummond does not disclose the method wherein the customer attribute information comprises data identifying the customer as having preferred customer status. However, Aarsteinsen discloses the method wherein the customer attribute information comprises data identifying the customer as having preferred customer status (page 2, lines 49-52). It would be obvious to one of ordinary skill in the art to combine using the label of preferred customer as disclosed by Aarsteinsen with the ATM promotional and communication services as disclosed by Drummond. The motivation would be to create a label for the customers which Drummond segments when their profile indicates they are a preferred customer. The use of special or preferred customer designation is used in various applications in industry such as frequent flier airline awards programs, frequent guest hotel awards programs, frequent diner award programs is well known. In addition to programs related to frequency of interaction, guests of special status are identified based on prestige, title (President, CEO, etc.), level of savings accounts such as high-yield account holders, large-scale investors, etc. These individuals are often addressed by the more senior management, provided with special services, special allowances made,

etc. For example, when a frequent flier checks in, the attribute information related to their account immediately identifies that traveler as a frequent flier and special boarding and sometimes seat upgrades are offered based on that data. They are both a special customer, and a customer with preferred status.

Regarding claim 13, Drummond discloses the method wherein the customer offer information comprises display information to be displayed at the terminal and directing the customer to a human administrator (column 16, lines 47-55).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond and Aarsteinsen as applied to claim 9 above, and further in view of "Freddie Mac is Avoiding Bad Loans" by P. Reeves, Nov. 23, 1997 (further referred to as Reeves). Neither Drummond nor Aarsteinsen disclose the method wherein the special customer status is a poor credit status. However, Reeves discloses the method wherein the special customer status is a poor credit status (page 1, lines 9-14). It would be obvious to one of ordinary skill in the art to combine the label of poor credit as disclosed by Reeves with the ATM promotional and communication services as disclosed by Drummond and Aarsteinsen. The motivation would be to create a label for the customers which Drummond and Aarsteinsen segment/individualize when their profile indicates they are a special customer and deserving of attention and focus such that special attention is noted regarding their poor credit.

Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drummond as applied to claim 17 above, and further in view of "Tanger Shoppers Score Big Outlet Savings During Super Bowl Scratch and Win Event" on PR Newswire, Dec, 1999 (further referred to as PR Newswire).

Regarding claim 18, Drummond does not disclose the method wherein the customer offer information further comprises game display information to be printed on a game card dispensed at the terminal, the game card having portions to be rubbed away to reveal information relating to game awards.

However, PR Newswire discloses a game card having portions to be rubbed away to reveal information relating to game awards (page 1, lines 11-14). It would be obvious to one of ordinary skill in the art to combine the distribution of game cards as disclosed by PR Newswire with the ATM dispensing mechanism as disclosed by Drummond. The motivation would be that in addition to vouchers and receipts and cash and tickets, etc. distributed, game cards would be distributed as an incentive to use the machine, or to build loyalty to the sponsoring institution.

Regarding claim 19, Drummond discloses the method wherein the customer offer information further comprises transaction display information on one or more transactions that may be selected by the customers and then conducted at the terminal (column 3, lines 20-25 and lines 48-51; column 16, lines 40-55; column 17, lines 12-15).

Regarding claim 20, Drummond discloses the method wherein the transaction display information displays information concerning standard transactions that are applicable to all customers who may use the terminal, such that transaction display information is displayed when none of the promotion display information, the administrator display information and game display information is transmitted by the information processing system to the terminal (column 3, lines 20-25; column 10, line 64 – column 11, line 8; column 21, lines 61-67).

Regarding claim 21, Drummond discloses the method wherein the transaction display information is displayed when the promotion display information, the administrator display information and the game display information is not displayed to the customer within a predetermined period of time after initiating a transaction at the terminal (column 14, lines 48-60; column 17, line 51 – column 18, line 10).

### ***Conclusion***

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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